

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 09/986,554
Attorney Docket No. Q67202

REMARKS

Claims 2-10 and 12-20 are all the claims pending in the application. Claims 2-10 and 12-20 are amended, and claims 1 and 11 are cancelled without prejudice or disclaimer. No new matter is presented.

Dealing with preliminary matters first, Applicant notes that the Examiner has returned the Modified Form PTO SB 08 A&B form submitted with the Information Disclosure Statement (IDS) of September 14, 2005 indicating that the references have not been considered. Applicant notes that the IDS stated that the concise statement of relevance was provided by the translation of the corresponding Japanese Office Action and an English translation of the pertinent portions thereof. Applicant refers the Examiner to M.P.E.P. § 609.049(a) III, which states as follows:

“Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.”

Accordingly, as Applicant has complied with the requirement for providing a concise statement of relevance, the refusal of the Examiner to consider these references is improper. Thus, the Examiner is kindly requested to initial and return the Modified Form PTO SB 08 A&B form submitted with the IDS in the next action.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hollander et al., “Shopping with other people’s money: the marketing management implications of surrogate-mediated consumer decision-making”, Journal of Marketing, April 1999, vol. 63, issue 2, page 102 (hereinafter “Hollander”) in view of Sills, “Taking the online express lane, computer, personal shoppers bring home the groceries, save you time”, Austin American Statesmen, February 19, 1997, pg. E1 (hereinafter “Sills”), further in view of Origination News, “Inspection adds value to appraisal”, December 1999, vol. 9, issue 3, page 12 (hereinafter “Origination News”). This ground of rejection is traversed at least because the combination of Hollander, Sills and Origination News fails to teach or suggest all the limitations of claims 2-10 and 12-20 and the Examiner has not established *prima facie* obviousness.

Claims 2 and 12

Independent claim 2 defines a novel ordering method presenting new features. For instance, the order method comprises, *inter alia*, transmitting sales information from an agent server to a user terminal via a communications network, wherein the sales information includes product listings for a plurality of items which are sold only at sales shops that are not accessible via the communications network, displaying the transmitted sales information, and transmitting a first inspection request signal to the agent server for a service charge associated with inspecting the selected item at a sales shop which is not accessible via the communications network. Claim 2 further recites determining the service charge based on contents of the first inspection request signal and a cost database, and transmitting the service charge that is determined to the user terminal. Further, the user terminal transmits a second inspection request signal to the server if

inspection of the selected item is instructed by the user, and an inspection report of the selected item is transmitted to the user terminal, wherein said inspection report includes results of inspecting the selecting item at the sales shop by an agent. In addition, claim 2 recites the features of displaying, the transmitted inspection report, wherein the user terminal transmits a purchase order of the selected item to be purchased by the agent if purchase of the selected item is instructed by the user, and transmitting an acknowledgment message to said user terminal in response to the purchase order. Independent claim 12 defines an ordering system reciting similar features.

Notwithstanding the Examiner's rejection, Applicant submits that the combination of Hollander, Sills and Origination News fails to reasonably teach or suggest all the limitations of claims 2 and 12. In this regard, Applicant notes that the Examiner initially relies on Hollander, which is alleged to teach "surrogate shopping whereby a surrogate shopper is defined as a commercial enterprise engaged and paid by the interested party on the behalf of the consumer to make or facilitate selection decisions." *See* Office Action at page 3. Nowhere, however, does Hollander mention an ordering method, as defined by claim 2, in which sales information is transmitted from a agent server to a user terminal, nor does suggest anything about sales information which includes product listings of a plurality of items which are sold only at sales shops that are not accessible via the communications network, as required by claim 2. Rather, Hollander provides nothing more than a discussion of the concept of a "surrogate shopper", who performs decision-making tasks or buying roles on behalf of consumer. *See* Hollander at page 3. Moreover, there is absolutely no mention of any user terminal, agent server, and communications

network, as required by claim 2. To the contrary, Hollander simply suggests that an individual may act as a surrogate on behalf of another.

The Examiner alleges that “[i]nherent in Hollander are the structure necessary to permit the consumer to make a decision on paid services” and further alleges that Hollander teaches “electronic, web, and Internet-based surrogacy systems.” *See* Office Action at page 3. Applicant respectfully submits that the Examiner’s reliance on inherency to compensate for features which are clearly not present in Hollander’s teaching is improper. In this regard, Applicant notes that Hollander merely states that “one fascinating development to watch will be the extent to which Internet and the Web provide opportunities for electronic surrogacy.” *See* Hollander at page 15. This statement cannot properly be relied upon as a basis for determining that the agent server, communications network and the user terminal, as defined by claim 2, are inherent in Hollander.

Indeed, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Further, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

However, as previously noted, Hollander nowhere mentions these elements, nor does Hollander suggest any transmission of sales information from the agent server to a user terminal. Further, there is no teaching of “sales information which includes product listings of a plurality

of items which are sold only at sales shops that are not accessible via the communications network”. In addition, Hollander does not suggest the features of transmitting a first inspection request signal to the agent server for a service charge associated with inspecting the selected item or and transmitting an inspection report of the selected item to said user terminal, as claimed.

The Examiner additionally relies on Sills, which is alleged to “disclose specifics pertaining to such online surrogate shopping systems.” *See* Office Action at page 4. However, Sills merely teaches a grocery delivery service in which a user places an order electronically from a website in which an order is placed and the selected items are retrieved and then delivered to the user. *See* Sills at pages 2-3. Thus, as the grocery items are simply ordered in Sills, there is no suggestion for the first inspection signal or the transmission of an inspection report, as claimed.

Further, the teaching of Origination News fails to compensate for the deficiencies of Hollander and Sills. In this regard, Applicant notes that Origination News merely teaches that “homebuyers should not rely solely on an appraiser’s report, but should instead get a professional home inspection performed...” *See* Origination News at page 1. However, the services of a professional home inspection service have absolutely no relation to an online grocery delivery service, nor does Origination news even mention any request of an inspection report from a user terminal or transmission of the inspection report from an agent server, as required by claim 2. Rather, Origination News merely discusses the benefits of having a professional home inspection performed.

Accordingly, the combination of Hollander, Sills, and Origination News fails to teach or suggest *at least* the features of transmitting a first inspection request signal to the agent server for a service charge associated with inspecting the selected item at a sales shop, transmitting a second inspection request signal to the server if inspection of the selected item is instructed by the user, and transmitting an inspection report of the selected item to the user terminal. Moreover, Applicant submits that the Examiner has impermissibly relied upon hindsight reasoning to improperly combine these clearly unrelated teachings.

As evidence above, the Examiner has failed to establish *prima facie* obviousness. Therefore, reconsideration and withdrawal of the rejection of claims 2 and 12 is requested. Further, dependent claims 3-4 and 13-14 are believed to be allowable at least by virtue of depending from claims 2 and 12, respectively.

Claims 5 and 15

Method claim 5 defines an ordering method comprising, *inter alia*, displaying, at a user terminal, transmitted sales information which is received from an agent server, wherein the user terminal transmits a first search request signal to the agent server to request a service charge associated with performing a search for a desired item if the desired item is not included among the plurality of items included in the product listings. Claim 5 further recites the features of displaying the service charge, wherein the user terminal transmits a second search request signal to said server if search for the desired item is instructed by the user, and transmitting a search report of said desired item to said user terminal. In addition, claim 5 recites the user terminal

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transmits a purchase order of the desired item to be purchased by the agent if purchase of the desired item is instructed by the user.

Applicant submits that at least these features are not taught or suggested by the combination of Hollander in view of Sills and Origination News. As previously noted, Hollander merely discusses the concept of a “surrogate shopper”, who performs decision-making tasks or buying roles on behalf of consumer and fails to mention any user terminal, agent server, and communications network, as required by claim 5. Nor does Hollander suggest transmission of first and second search request signals, as claimed.

Sills, which merely teaches that items selected from a website are ordered and delivered to a user, likewise fails to suggest at least the features of transmitting first and second search request signals and the transmission of a search report of the desired item, as claimed. Indeed, the “items” in Sills web-based ordering system are all included in a list which is displayed to the user. Sills does not mention or suggest the features of requesting a search report for an item which is not included in product listings which are displayed at a user terminal.

Further, the teaching of Origination News simply teaches that a professional home inspection report should be performed in addition to an appraisal. Thus, Origination News does not suggest a search report for a product that is not included in product listing displayed at a user terminal, or the transmission the first and second search request signal.

As evidenced by the foregoing, the combination of Hollander, Sills, and Origination News fails to teach or suggest all the limitations of the ordering method defined by claim 5. For similar reasons, the combined teaching of Hollander, Sills and Origination News fails to suggest

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all the features of the ordering device of claim 15. Further, Applicant submits that the Examiner has impermissibly relied upon hindsight reconstruction to improperly combine these references, and the grounds of rejection fail to establish that the combination of features recited by claims 5 and 15 would have been *prima facie* obvious. In addition, Applicant submits that claims 6-7 and 16-17 are allowable at least by virtue of depending from claims 5 and 15.

Claims 8 and 18

Claims 8 and 18 respectively define an ordering method and ordering system reciting similar features as recited in claims 2, 5, 12 and 15. Thus, claims 8 and 18 are believed to be allowable at least for the reasons discussed above. Further, claims 9-10 and 19-20 are believed to be allowable at least by virtue of depending from claims 8 and 18, respectively.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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